

However, claims 11-16, 18, 20-23 are merely objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

Claim 11 further limits claim 10, which depends directly on independent claim 1. In the presently proposed amendment the limits of claim 11 have been incorporated into claim 1. Thus R₂ as methyl is no longer claimed. Since claims 10 and 11 would fail to further limit amended claim 1, applicants propose to cancel them. Accordingly, applicants aver that claim 1, and necessarily all of the remaining claims dependent thereon, i.e. 2-6 and 12-25, are now allowable.

Reconsideration and withdrawal of the rejections over Cowman et al. and Rohringer et al. is respectfully solicited in light of the remarks *supra*.

Applicants also aver that only hindsight of the subject matter of allowable claims 1-6 and 12-25 would have motivated the artisan to carry out the process of claims 31-36, which of course is an improper basis for a rejection under 35 U.S.C. § 103(a). The examiner is requested to note the recent *In re Ochiai* [37 USPQ2d 1127(CAFC, 1995)] and *In re Brouwer* [37 USPQ2d 1663 (CAFC, 1995)] decisions and the Commissioner's OG Notice concerning them entitled "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer*, and 35 U.S.C. § 103(b)", 1184 Off. Gaz. Pat. Office 86 (March 26, 1996) in this regard. According to the Guidance

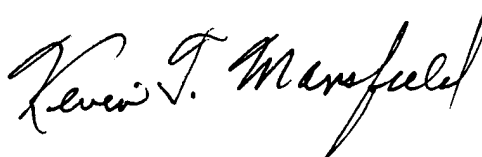
... to facilitate examination under §103, where product and process claims are presented in the same application, applicant may be called upon under 35 U.S.C. § 121 to elect claims to either the product or process. The claims to the non-elected invention will be withdrawn from further consideration. However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim.

In accord with the guidelines, on finding the amended product claim 1 to be allowable, rejoinder of claims 31-36, directed to a method of use of the product of amended claim 1 is requested.

Since there are no other grounds of objection or rejection, passage of this application to issue with claims 1-6, 12-25 and 31-36 is earnestly solicited.

Applicants submit that the present application is in condition for allowance. In the event that minor amendments will further prosecution, Applicants request that the examiner contact the undersigned representative.

Respectfully submitted,

A handwritten signature in black ink, reading "Kevin T. Mansfield". The signature is written in a cursive style with a large, stylized "K" and "M".

Ciba Specialty Chemicals Corporation
540 White Plains Road
Tarrytown, New York 10591
(914) 785-7127
KTM22076A3

Kevin T. Mansfield
Agent for Applicants
Reg. No. 31,635

OCT 10 2013